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Paper No. 8

SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037-3213

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DEC 13 2001

OFFICE OF PETITIONS

In re Application of :
Lachen Bennai et al :
Application No. 09/736,158 : DECISION REFUSING STATUS
Filed: December 15, 2000 : UNDER 37 CFR 1.47(a)
Attorney Docket No. Q62302 :
:

This is in response to the petition under 37 CFR 1.47(a), filed August 14, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the nonsigning inventor. Applicant lacks item (1) set forth above.

The declaration of Bernard Lamoureaux, an employee of Compagnie Financiere Alcatel, a subsidiary of Alcatel, the asserted owner of the instant application, states that, prior to seeking execution of the Declaration and Assignment forms, he was advised that nonsigning inventor Christian Laroque had moved to a new address in Germany and that, on December 11, 2000, he sent papers to Mr. Laroque at his new

address in Germany. However, the envelope was returned by the postal service marked as "Nicht abgeholt" (not claimed). A copy of the unclaimed envelope accompanies the petition as evidence. The statement contained in the petition signed by Paul J. Wilson indicates that nonsigning inventor Christian Laroque has left the employ of the assignee and his whereabouts are unknown.

It is unclear from the record whether nonsigning inventor Laroque cannot be located or whether the whereabouts of Mr. Laroque are known but that Mr. Laroque has simply failed to claim the package mailed to him on December 11, 2000. Therefore, petitioner is requested to provide a statement as to whether the package was in fact mailed to the current address of the nonsigning inventor. If that is the correct address, petitioner should make another attempt to deliver the package (specification, claims, drawings and oath or declaration) to Mr. Laroque since Mr. Laroque may have been out of town and could not have claimed the package within the period held by the postal service.

If Mr. Laroque cannot be located, then rule 47 applicant has not provided the evidence necessary to establish the *diligent efforts* made to locate the nonsigning inventor and provide the inventor with a copy of the application papers. Where inability to find or locate a named inventor is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. The statement(s) of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. At the very least, a search of the telephone directories should be undertaken of the regions where it is suspected the nonsigning inventor may reside. Additionally, petitioner should inquire of former coworkers to ascertain the current address for nonsigning inventor Laroque. Petitioner should also utilize regional, national, or international registries to seek information regarding the location of nonsigning inventor Laroque. Copies of the results of such searches must be referred to in any renewed petition. See MPEP 409.03(d). If Mr. Laroque is located, then petitioner should mail a copy of the application papers (specification, claims and drawings) to the nonsigning inventor with a request that he sign the declaration for the patent application. The cover letter of instructions should include a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the

person to whom the refusal was made. Statements by a party not present when an oral refusal is made is not acceptable. Additionally, when there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. On the other hand, if the refusal is in writing, a copy of the document evidencing that refusal must be made part of the affidavit or declaration. See MPEP Section 409.03(d).

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. **If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.**

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47(a) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-8680.

Frances Hicks
Frances Hicks

Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy